



262

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: IDEI, et al.

Group Art Unit: 1774

Serial No.: 09/508,617

Examiner: L. Ferguson

Filed: March 14, 2000

P.T.O. Confirmation No.: 8477

For: PAPER FOR INK JET AND ELECTROPHOTOGRAPHIC RECORDING

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 15, 2005

Sir:

In response to the Office Action dated April 1, 2005, Applicants respectfully request reconsideration of the 35 U.S.C. § 102(b) rejection of claims 1 and 5 as anticipated by U.S. Patent 4,279,961 to Fujioka et al. (hereinafter "Fujioka et al."), and the 35 U.S.C. § 103(a) rejection of claims 3 and 4 as unpatentable over Fujioka et al. in view of U.S. Patent 4,207,142 to Shepherd (hereinafter "Shepherd").

The Examiner has stated:

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) has been maintained in view of Shepherd (U.S. 4,207,142) and Fujioka et al (U.S. 4,279,961) has been used as a 102(b) reference. Fujioka discloses a paper comprising a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins, such as quaternary ammonium salts, a surface resistivity of 10^6 to 10^{10} ohms and 2 to 20 g/m² by dry weight (column 5, lines 33-44) where the resistivity is higher in an atmosphere of lower humidity (column 1, lines 39-48). Fujioka further discloses coating a paper (column 8, lines 9-11). Because Fujioka discloses a paper comprising the same cationic resin

U.S. Patent Application Serial No. 09/508,617
Response filed June 15, 2005
Reply to OA dated April 1, 2005

(quaternary ammonium salt) and surface resistivity as instantly claimed, the cation equivalent is an inherent feature.

Applicant argues the cationic resin of Fujioka et al is not the cationic resin which is claimed by Applicant's. Examiner respectfully disagrees because Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the sheet comprising cationic resins, such as quaternary ammonium salts (column 5, lines 33-44), which are the same cationic resin material used in Applicant's disclosure. Applicant further argues Fujioka does not explicitly teach a cation equivalent measured by colloidal titration method. Because Fujioka discloses a paper comprising the same cationic resin (quaternary ammonium salt) and surface resistivity as instantly claimed, the cation equivalent is an inherent feature. Applicant argues the surface resistivity of Fujioka meets a single point of instant claim 5.

10^{10} ohms is part of the claimed range and therefore meets the limitation of instant claim 5.

Applicants respectfully disagree as to the teaching of the cation equivalent measured by colloidal titration method. Merely because Fujioka et al. discloses a paper comprising the same cationic resin and surface resistivity as claimed, it does not follow that the cation equivalent measured by the colloidal titration method is inherent.

Furthermore, the final product disclosed in Fujioka et al. is an electrostatic record material comprising a paper substrate, an electroconductive layer and a record forming layer. The portion of Fujioka et al. quoted by the Examiner (column 5, lines 33-44) relates not to the final product but to an intermediate product which is composed of a paper substrate and an electroconductive layer. Such an intermediate product per se cannot be used as a recording material. In fact, Fujioka et al. does not disclose or suggest use of the intermediate product per se or any advantages of the

U.S. Patent Application Serial No. **09/508,617**
Response filed June 15, 2005
Reply to OA dated April 1, 2005

intermediate product.

Thus, the intermediate product described in Fujioka et al. does not correspond to presently claimed paper for ink jet and electrophotographic recording, which is a final product and can be used per se.

Moreover, the Examiner alleges that in instant claim 1, the phrase “as measured by colloidal titration method” introduces a process limitation to the product claim, and hence claim 1 is a product-by-process claim (paragraph bridging pages 2 and 3 of the Office Action). However, this phrase specifies the cation equivalent of the cationic resin which is one of the components of the recording paper of the present invention. Thus, the phrase does not relate to a process for producing a recording paper, as incorrectly alleged by the Examiner. It is respectfully submitted that claim 1 is not a product-by-process claim but a product claim.

Additionally, concerning claim 4, the Examiner has argued that although Fujioka et al. does not explicitly teach making the paper from pulp, it would have been obvious for the paper to contain pulp because paper is conventionally made from pulp (item 5 of the Office Action). The Examiner seems to overlook that use of a waste paper pulp is essential in claim 4. Thus, the Examiner’s rejection with respect to the patentability of claim 4 is not well-taken and should be withdrawn.

Thus, the 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections should be withdrawn.

U.S. Patent Application Serial No. **09/508,617**
Response filed June 15, 2005
Reply to OA dated April 1, 2005

In view of the remarks above, claims 1 and 3-5 are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP


William L. Brooks
Attorney for Applicant
Reg. No. 34,129

WLB/ak
Atty. Docket No. **000225**
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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